

REMARKS

This Amendment and Response to the Non-Final Office Action is being submitted in response to the Non-Final Office Action mailed November 25, 2008. Claims 1-30 are pending in the Application, of which claims 1-10 have been previously cancelled (See "Third Substitute Preliminary Amendment" dated February 7, 2008).

The Examiner has objected to the specification for failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner has stated there is no mention in the specification of a polymer concentration of "more than 30 % by weight." Claims 11-30 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 11-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen (U.S. Pat. No. 4,405,680), Grube et al (U.S. Pat. No. 5,055,135), or Ohtsuka et al (U.S. Pat. No. 5,925,695) in view of Schoenke (U.S. Pat. No. 4,032,491), Buck et al (U.S. Pat. No. 4,530,652), Kalkanoglu (U.S. Pat. No. 5,437,923), Fensel et al (U.S. Pat. No. 6,524, 980), Driesken et al (U.S. Pat. No. 6,538,053) or Stephens et al (U.S. Pub. No. 2003/0149140).

In response to these rejections, Claims 11 and 24 have been amended to further clarify the subject matter which Applicant regards as the invention, without prejudice or disclaimer to continued examination on the merits. These amendments are fully supported in the Specification, Drawings, and Claims of the Application and no new matter has been added. Based upon the amendments and the arguments presented herein, reconsideration of the Application is respectfully requested.

REJECTION OF CLAIMS UNDER 35 U.S.C. §112

Claims 11-30 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner has stated there is no mention in the specification of a polymer concentration of “more than 30% by weight.” Applicant respectfully disagrees with the Examiner.

In fact, Applicant believes *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (C.C.P.A. 1976) supports Applicants position. The issue in *In re Wertheim* dealt with whether the Applicant could claim priority from an earlier-filed foreign application. The invention related to a drying method for producing freeze dried coffee. The application claimed a process in which a coffee extract was prepared by the percolation of hot water through ground coffee beans, and the extract was concentrated to have a solid content between 35 percent and 60 percent. The Examiner refused to provide the Applicant priority, because the earlier-filed foreign application included a range of 25 to 60 percent and the Examiner claimed the earlier-filed foreign application did not contain an adequate description of the range as claimed in the Applicant’s application.

On Appeal, the CCPA reversed the rejection of the Examiner. The CCPA held that the range of between 35 and 60 percent was adequately supported in the earlier-filed foreign application, and therefore, was patentable. In fact, the CCPA stated “in light of the description of the invention as employing solids content within the range of 25-60%..., we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35-60% solids content range to be part of appellants’ invention and would be led by the [earlier filed foreign application] so to conclude.”

In the present case, the specification, as amended by Applicants in their October 29, 2008 Response, specifically states a range of “more than 20 wt% to 50 wt%.” However, the Examiner has rejected the present application under § 112 because the Claims contain a limitation of “from more than 30 to 50 wt%.” The Examiner further relies upon *In re Wertheim* to support his position. It is respectfully submitted that *In re*

Wertheim does not support the Examiner position, and instead, supports the position of the applicant.

The similarities in *In re Wertheim* and the present application are striking and require an identical result. First, the claims of the present application contain a range narrower than that disclosed in the present application's specification. Second, the range claimed within the present application is within the range stated in the specification. Third, a person skilled in the art would consider the range claimed in the present invention to be part of the invention disclosed in the provisional application. Therefore, by simple application and incorporation of the *In re Wertheim* opinion to the facts of the present case, one must conclude that claims of the present application are explicitly present in the specification of the present application.

REJECTION OF CLAIMS 11-30 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER HANSEN (U.S. PAT. NO. 4,405,680), GRUBE ET AL (U.S. PAT. NO. 5,055,135), OR OHTSUKA ET AL (U.S. PAT. NO. 5,925,695) IN VIEW OF SCHOENKE (U.S. PAT. NO. 4,032,491), BUCK ET AL (U.S. PAT. NO. 4,530,652), KALKANOGLU (U.S. PAT. NO. 5,437,923), FENSEL ET AL (U.S. PAT. NO. 6,524, 980), DRIESKEN ET AL (U.S. PAT. NO. 6,538,053) OR STEPHENS ET AL (U.S. PUB. NO. 2003/0149140)

Claims 11-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen (U.S. Pat. No. 4,405,680), Grube et al (U.S. Pat. No. 5,055,135), or Ohtsuka et al (U.S. Pat. No. 5,925,695) in view of Schoenke (U.S. Pat. No. 4,032,491), Buck et al (U.S. Pat. No. 4,530,652), Kalkanoglu (U.S. Pat. No. 5,437,923), Fensel et al (U.S. Pat. No. 6,524, 980), Driesken et al (U.S. Pat. No. 6,538,053) or Stephens et al (U.S. Pub. No. 2003/0149140). It is respectfully submitted, however, that the cited references fail to anticipate or render obvious the disclosed invention. Specifically, the cited references fail to disclose, suggest, or teach a thin block copolymer modified bituminous felt or pavement including a vinyl content in the range of from about 8 to about 23 mole %.

Schoenke discloses a roofing composition and resulting product that comprises 5-40% of asphalt and 60-95% of a block copolymer.

Hansen discloses a roofing shingle composed of a block copolymer and asphalt composition, wherein the block copolymer is about 6 to about 30 wt% of the block copolymer.

Buck et al disclose an asphalt composition. The asphalt composition comprises an asphalt and about 10 to about 25 wt% of the block copolymer. The vinyl content of the block copolymer is at least about 25 percent, preferably in the range of 25-50 percent.

Grube et al disclose a flame retardant bitumen. The bitumen includes a styrene copolymer between about 2 and about 20 wt%.

Kalkanoglu discloses a halogen-free flame-retardant bitumen roofing composition. The styrene copolymers in the composition are in a concentration of about 2 to about 25 wt% based upon the total weight of the composition.

Ohtsuka et al disclose a curable composition, a cured article therefrom having improved properties, an asphalt emulsion, an asphalt mixture for paving, and a cured article prepared therefrom having excellent water permeability. The composition in Ohtsuka is limited to an aromatic vinyl compound.

Fensel et al disclose a roofing membrane using composite reinforcement constructions. The roofing membrane includes an SBS block copolymer in the range of about 5 to about 22 wt%.

Drieskens et al disclose a watertight roofing panel of a bituminous composition. The composition contains 5 to 25 wt% of rubbery polymers comprising at least (a) radial styrene-butadiene block copolymer, (b) linear and/or radial styrene-isoprene block copolymer, and (c) styrene-diene diblock copolymer, preferably of statistical interlinking.

Stephens et al disclose a polymer modified bitumen compositions. The polymer modifier is present in the bituminous composition in an amount in the range of from 0.5 to 25% by weight.

On the other hand, amended claims 11 and 24 of the disclosed invention claim at least one block copolymer, comprising at least two poly(vinyl aromatic) blocks and at least one poly(conjugated diene) block having a vinyl content in the range of from about 8 to about 23 mole%.

Schoenke, Hansen, Buck et al, Grube et al, Kalkanoglu, Fensel et al, Drieskens et al, Stephens et al, and Ohtsuka do not disclose, suggest, or teach a block copolymer including a vinyl content in the range of from about 8 to about 23 mole %.

Accordingly, Claims 11 and 24 have been amended to further clarify the invention with these limitations.

These rejections are respectfully traversed, and reconsideration and withdrawal of the rejections are respectfully requested.

It is also respectfully submitted that the Examiner has not provided adequate information concerning his §103 rejection to allow Applicant to appropriately and adequately respond. As required by 35 U.S.C. §103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

As further stated in M.P.E.P 706.02(j), it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.

Applicant previously requested the Examiner to explain why one of ordinary skill in the art at the time of the invention would have been motivated to modify the cited references or combine the cited reference teachings. However, in the Non-Final Office Action, the Examiner has not provided any such reasoning as previously requested.

CONCLUSION

Applicant would like to thank Examiner for the attention and consideration accorded the present Application. Should Examiner determine that any further action is necessary to place the Application in condition for allowance, Examiner is encouraged to contact undersigned Counsel at the telephone number, facsimile number, address, or email address provided below. It is not believed that any fees for additional claims, extensions of time or the like are required beyond those that may otherwise be indicated in the documents accompanying this paper. However, if such additional fees are required, Examiner is encouraged to notify undersigned Counsel at Examiner's earliest convenience.

Respectfully submitted,

Date: February 24, 2009

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